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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stout Industries, Inc.

Serial No. 75/713,192
Serial No. 75/713,242

Paul M. Denk, Esq. for Stout Industries, Inc.

John Dwyer, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Simms, Chapman and Holtzman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The two applications involved herein were filed on May 24, 1999 by Stout Industries, Inc. (a Delaware corporation) to register on the Principal Register the mark STOUT.COM, application Serial No. 75/713,192 for "custom design of signs and sign bearing fascia for advertising for others" in International Class 42, and application Serial No. 75/713,242 for "manufacture of general product line in the

field of signs and sign bearing fascia for advertising to the order and specification of others" in International Class 40.¹

Application Serial No. 75/713,192 was based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). It was published for opposition on December 21, 1999; and a notice of allowance issued on March 14, 2000. On September 11, 2000 (via certificate of mailing), applicant filed a statement of use, alleging use since September 8, 2000, and including a specimen in the form of a printout of a web page from applicant's web site.

Application Serial No. 75/713,242 was based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). It was published for opposition on December 28, 1999; and a notice of allowance issued on March 21, 2000. On September 11, 2000 (via certificate of mailing), applicant filed a statement of use, alleging use since September 8, 2000, and including a specimen in the form of a printout of a web page from applicant's web site.

¹ Stout Industries, Inc. filed a third application (Serial No. 75/712,594) for different services for the mark STOUT.COM on May 24, 1999. That application is also on appeal to the Board. A decision on that application will issue separately. (In addition, applicant filed on that date a fourth application, Serial No. 75/712,606, for the mark STOUT.COM for "non-luminous and non-mechanical metal signs; metal sign bearing fascia" in International Class 6, and it issued as Registration No. 2,474,220 on July 31, 2001.)

In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

In the first Office action in each application, the Examining Attorney found the web site printout specimen (which shows "www.stout.com") failed to show service mark usage, and being merely a component of a web site address, failed to function as a service mark.

In response, applicant filed another statement of use, including as a specimen a promotional card given out to customers and potential customers.

The Examining Attorney again rejected the specimens, explaining that the new specimen is unacceptable because it does not show use of the mark for the respective services identified in each application; and the Examining Attorney required that applicant submit substitute specimens, supported by an affidavit or declaration, showing use of the mark for the identified services.

Applicant then filed a third statement of use, and including as specimens (1) a duplicate of the promotional card previously submitted, and (2) a photograph of a portion of a sign bearing the mark STOUT.COM.

The Examining Attorney again rejected the specimens in each application, and made final the refusal on the ground that the specimens submitted by applicant do not show use of the mark for the services identified in the application.

Applicant filed a notice of appeal and a request for reconsideration in each application. Applicant argued in its requests for reconsideration that it has submitted a printout of a web page, a promotional card, and a photograph, and applicant simply does not understand what more it could do to "verify and prove its usage, through specimen submission, to the Trademark Office of its usage of this mark...." (request for reconsideration filed August 5, 2002, p. 2).

The Board remanded the applications (on January 8, 2003 and September 19, 2002, respectively) to the Examining Attorney for consideration of applicant's arguments. The Examining Attorney denied the request for reconsideration in each application (on October 18, 2002 and January 23, 2003, respectively), specifically addressing each of the three specimens. The first specimen showed "www.stout.com" which, as used on the printout of a web page, was, according to the Examining Attorney, not used in the manner of a service mark but rather was simply a web address, with the term "stout.com" being only a portion thereof. The

Examining Attorney argued the second specimen (the promotional card) does not reference or discuss in any way the specific services in the two applications; and the third specimen (a photograph of a portion of a sign) may identify the source of the sign but does not relate to the identified services.

Briefs have been filed, but applicant did not request an oral hearing in either application.

The Examining Attorney's position is essentially that the specimens do not show the mark used in the sale or advertising of the identified services, "custom design of signs and sign bearing fascia for advertising for others" and "manufacture of general product line in the field of signs and sign bearing fascia for advertising to the order and specification of others." With specific regard to each specimen, the Examining Attorney contends that the first specimen (printout of a page from applicant's web site) does not support use of the term STOUT.COM as a mark and is used only as a portion of the web address "www.stout.com";²

² The Examining Attorney argued in his brief on appeal that applicant withdrew its first specimen (the printout of a web page) by not responding on the merits, but instead submitting a substitute statement of use. Based thereon, the Examining Attorney refused to consider the web page printout as a specimen in these two applications. Aside from the fact that the Examining Attorney had treated the printout page on the merits in his denial of applicant's requests for reconsideration without asserting that applicant had withdrawn these specimens, the

that the photographs show the mark STOUT.COM but they are clearly photographs of portions of signs (appearing on a vending machine for "7UP") and would not be perceived as supporting use of applicant's mark for the identified services; and that the card given out to potential customers also shows the mark STOUT.COM but does not reference even indirectly the identified services in either application, and based on the other wording on the specimen would be perceived as relating to marketing and sales and brand building services, but not to custom design of and manufacturing of signs and sign bearing fascia.

The Examining Attorney concludes that each of the specimens submitted by applicant fails to demonstrate use of the mark in association with the respective identified services (set forth above), as required by Trademark Rules 2.56(a) and (b)(2) and 2.88(b).

Applicant essentially contends that its extensive usage of STOUT.COM in applicant's various materials such as

Examining Attorney also cited no authority to support such a position. His citation to TMEP §718.03 (3d ed. 2002) "Incomplete Response" deals with incomplete responses to Office actions and the Examining Attorney then holding the application abandoned as a result thereof. While it is true that applicant did not argue on the merits as to its use of "www.stout.com," the Examining Attorney never held the applications abandoned because of incomplete responses. It would be unfair to applicant to remove the first specimen from the record in this manner. Accordingly, we have considered all of applicant's specimens in each application in reaching our decision herein.

on its web page or on cards given out to potential customers "is adequate proof of substantial and continuous usage of applicant's mark in this business of providing a custom design of signs and sign bearing fascia for others" (brief, p. 5); that applicant has used the mark in a variety of displays to indicate source of origin, each of which supports applicant as the source of the respective identified services; and that the web page clearly shows that applicant builds point-of-purchase signage, and if the customer "is looking for stronger ideas to bolster sales and build brands, they have come to the right place, namely, applicant's sign manufacturing business," and that this usage "should be quite indicative of the nature of applicant's business." (Brief, p. 5.)

The requirements for specimens of use of a mark in connection with services differ from the requirements for specimens of use of a mark in connection with goods. Although trademarks appear directly on the goods or on the containers or labels for the goods, service marks are used in connection with the services. Implicit in the statutory definitions of a "service mark" is the requirement that there be some direct association between the mark and the services, i.e., that the mark be used in such a manner that it would readily be perceived as identifying the source of

such services. See *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987); and *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997).

That is, specimens must show an association between the mark and the services for which registration is sought; and specimens which show the mark, but with "nothing directed to prospective customers of the stated services which could have created an association, direct or otherwise, between the mark and the services set forth in the application" are insufficient. *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1319 (TTAB 1994). See also, *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989).

In this case, we agree with the Examining Attorney that two of the specimens (the promotional card and the photographs of portions of a sign) submitted by applicant do not show use of the mark in connection with the specific services identified in the respective applications. The specimens which are portions of a sign (appearing on a vending machine for "7 UP") include the following wording:

Manufactured by Stout Sign Co.
St. Louis Mo. Made in U.S.A.-9716127
Authorized by Cadbury Beverages Inc.
Total Production 925
stout.com

This use does not indicate anything which would create in the mind of the relevant consumers an association between the mark and the service activity (custom design of signs and manufacturing of signs to the specifications of others). At best, this may support trademark use for signs, but it does not support service mark use for applicant's respective identified services.

The promotional card is reproduced below:



The wording thereon, such as:

"STOUTMARKETING
Building Stronger Brands Worldwide";
and

"Looking to boost sales and build stronger brands?"

does not create an association in purchasers' minds with applicant's identified services of "custom design of signs and sign bearing fascia for advertising for others" and

"manufacture of general product line in the field of signs and sign bearing fascia for advertising to the order and specification of others." These promotional cards may identify or support a marketing or advertising service, but not those set forth above.

We find these specimens of record do not support use of the mark STOUT.COM in connection with the identified services because they do not show applicant's use of the mark in association with the sale or advertising of the services specified in the application.

With regard to the first specimen, the printout of a web page, we find there is an association with the respective identified services, as shown by the following statement thereon: "Just like good brands and good business relationships, Stout builds P-O-P [point-of-purchase] signage and imaging systems to last. We build most of our signs out of metal, a practice we'll keep until the day we find something better." However, there is no use of STOUT.COM, rather, the usage is "www.stout.com" appearing below the copyright notice "© 2000 Stout Marketing ®." That is, while the printout specimens show a sufficient association with the identified services, they do not show use of the mark STOUT.COM. Rather, the use is that of a web address, which is not functioning as a service mark for

the identified goods. See *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998). See also, *Lockheed Martin Corp. v. Network Solutions Inc.*, 985 F. Supp. 949, 44 USPQ2d 1865, 1871 (CDCA 1997), *aff'd* 194 F.3d 980, 52 USPQ2d 1481 (9th Cir. 1999); *Data Concepts Inc. v. Digital Consulting Inc.*, 150 F.3d 620, 47 USPQ2d 1672, concurring opinion, *Merritt* (6th Cir. 1998); and 1 J. Thomas McCarthy, Trademarks and Unfair Competition, §7:17.1 (4th ed. 2000).

Decision: The refusal to register on the basis that none of the specimens show use of the mark in connection with the identified services is affirmed in each application.